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In re Application of :
ABILDGAARD, Flemming :
U.S. Application No.: 10/579,883 :
PCT No.: PCT/IB03/06285 :
Int. Filing Date: 18 November 2003 :
Priority Date: None :
Attorney's Docket No.: 884A.0139.U1(US) :
For: A HAND-PORTABLE ELECTRONIC :
DEVICE FOR VERIFYING AN INPUT :
TEST SEQUENCE OF CHARACTERS :
AGAINST A PREDETERMINED :
SEQUENCE OF CHARACTERS :

DECISION

The decision is in response to the "Petition Under 37 CFR §1.47(b)" submitted on 09 March 2007.

BACKGROUND

On 01 February 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a \$130.00 surcharge fee was required. Petitioners were given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 09 March 2007, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, a \$200.00 petition fee; a \$130.00 surcharge fee; a statement of facts signed by Katriina Ropponen; copy of a letter dated 18 April 2006 ("Exh. A"); and a copy of a declaration signed by the 37 CFR 1.47(b) applicant.

DISCUSSION

A petition under 37 CFR 1.47(b) requires (1) the petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be located, (3) a statement of the last known addresses of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee has been paid. The last known address of the sole inventor is listed as:

Klostervej 7,
2. Floor,
3.door, DK-5000 Odense
Denmark

Regarding item (4), the 37 CFR 1.47(b) applicant provided a declaration listing the name, residence, mailing address and citizenship of the sole inventor. The declaration was signed by the attorney for applicant on behalf of the inventor. Section 409.03(b) of the MPEP states that "[w]here the oath or declaration is being signed on behalf of an assignee, see MPEP § 324."

Section 324 of the MPEP states, in part:

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii) . . . A person having a title (**manager**, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

An attorney is not a position that is assumed to have the authority to sign for the assignee. However, the 37 CFR 1.47(b) applicant has set forth that he is authorized to act on behalf of the assignee. As such, the declaration complies with 37 CFR 1.497(a) and (b). This is sufficient to satisfy item (4).

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP) states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In the petition, the 37 CFR 1.47(b) applicant includes such a statement of abandonment which is sufficient.

Thus, items (1), (3), (4) and (6) of 37 CFR 1.47(b) are completed.

Concerning item (2), petitioner claims that the inventor cannot be located, or refuses to cooperate. Petitioner has shown neither.

Section 409.03(d) of the MPEP discusses where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included [*in the*] statement of facts. It is important that the statement contain facts as opposed to conclusions.

It is clear from the MPEP that a "diligent effort" to locate the nonsigning inventor must be shown by the 37 CFR 1.47(b) applicant. However, the 37 CFR 1.47(a) applicant has not submitted any evidence showing that an attempt was made to locate and contact the nonsigning inventor. No documentary efforts of any searches for the inventor were submitted and the steps taken to locate the nonsigning inventor were not discussed in the statement of facts by Ms. Ropponen. This does not meet the "diligent effort" standard.

Section 409.03(d) of the MPEP also discusses a refusal to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the

inventor is willing to receive the papers in order to sign the oath or declaration. . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, the 37 CFR 1.47(b) applicant has not provided a complete copy of the subject application (specification, claims and drawings) as required for a refusal. In addition, there was no showing that the inventor received any papers, or has any knowledge of the subject application. For these reasons, item (2) is not satisfied.

With regards to item (5), section 409.03(f) of the MPEP states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. . . .

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b) a copy of that agreement should be submitted. . . .

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant.

Here, the 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned national stage application of PCT/IB03/06285 because the inventor made the invention while he was an employee of Nokia Corporation. Counsel states that irrelevant portions of European law "give entitlement of the invention to Nokia Corporation." The statements by counsel are insufficient.

Petitioner must demonstrate that the invention was made while the inventor was working for Nokia Corporation and the invention was within the scope of the inventor's duties. A declaration by a person with first hand knowledge of these facts is required. Since there is no assignment, petitioner must show that Nokia Corporation is entitled to the invention by law. This may be demonstrated by a signed employment agreement clearly indicating that all inventions are the property of the company, or using a legal memorandum by an attorney familiar with the law of the country involved. Petitioner has provided neither. For these reasons, item (5) is also not yet satisfied.

All of the requirements of 37 CFR 1.47(b) are not yet complete.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time are available.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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